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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,536	07/29/2003	Christopher Hall	81044209	1535

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EXAMINER	
SEE, CAROL A	

ART UNIT	PAPER NUMBER
3696	

MAIL DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/604,536	HALL ET AL.	
	Examiner	Art Unit	
	Carol See	3696	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *01 December 2008*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-4,6-9,11-13,35-39 and 41* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-4,6-9,11-13,35-39 and 41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. In response to Applicant's Arguments/Remarks (dated 12/1/2008), Examiner acknowledges cancellation of claim 5 and amendment of claims 1, 35 and 41.

2. Claims 1-4, 6-9, 11-13, 35-39 and 41 are pending in this action.

Response to Argument

3. Applicant's arguments with respect to claims 1-4, 6-9, 11-13, 35-39 and 41 have been considered but are moot in view of the new ground(s) of rejection. A re-evaluation of Applicant's claim language, Applicant's amendments and previous presentations of prior art provide the basis for the new grounds of rejection.

Claim Objections

4. Claim 8 is objected to because of the following informalities: claim 8 recites "present future" while claim 2, from which it depends, recites "present/future". Consistent terminology should be used. Appropriate correction is required.

5. Claims 6 and 7 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 1, from which claims 6 and 7 depends contains a receiving a future interest step. The information about a vehicle dealer transferring a vehicle and a vehicle consumer

receiving legal title do not serve to further limit the performance of the method step as recited. The language further fails to limit the language of claim 1 by adding additional steps to be performed as part of the method.

Claim Rejections - 35 USC § 112

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

7. Claims 1, 35 and 41 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The recitation "the legal title price being an amount of money paid for a present possessory interest in the vehicle" is not described in the specification.

8. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

9. Claims 1, 35 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. Claims 2-4, 6-9, 11-13 are rejected as depending from claim 1. Claims 36-39 are rejected as depending from claim 35.

Claims 1 and 35 are rendered indefinite because some of the claim language does not positively recite method steps as indicated by the wording of the preamble. In claim 1, the clause that begins the vehicle financing..." does not indicate a step in a method is actually occurring. In claim 35, the clause that begins "the financing company..." does not indicate a step in a method is actually occurring. The first word in the individual clauses of a method claim must indicate some action is occurring.

Re claim 3, the meaning of "unrestricted legal title" and "unrestricted legal title price" is unclear.

Further, the preamble of claim 35 and the body of claim 35 fail to agree. The preamble recites a method for transferring legal title; however, the body of the claim is not commensurate with the recitation in the preamble. The body of the claim fails to positively recite transferring legal title.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 1, 3, 4, 7, 11-13 and 35-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sabella (U.S. 2003/0110108) in view of LaCombe, Jr. et al. (U.S. 2005/0289036)(hereinafter LaCombe). Please note that the Examiner has determined that the invention of Sabella is supported by the provisional application (Application No. 60/339,207) to which Sabella claims priority. Accordingly, the disclosure of Sabella antedates Applicant's claimed invention. Upon review, examiner has determined that the invention disclosed in LaCombe is supported by the nonprovisional application (Application No. 09/718,749 filed on November 22, 2000) to which LaCombe claims priority. Accordingly, the disclosure of LaCombe antedates applicant's claimed invention.

As to claim 1, Sabella shows a method for providing financing by a vehicle financing company for acquisition of a vehicle by a vehicle consumer, the method comprising:

receiving a future interest in a vehicle by a vehicle financing company in consideration for a future interest price paid by the vehicle financing company upon transfer of a legal title in the vehicle to a vehicle consumer in consideration for a legal title price for a legal title term, the legal title price being an amount of money paid for a present possessory interest in the vehicle, wherein the receiving step is accomplished at least partially by utilizing an at least one computer and at least one computer network (paras. 0002, 0008, 0021-0027, 0030-0034, showing a seller parceling interests in property, inclusive of tangible property that is not real estate, to individuals or entities who desire an interest in that property. A primary investor – e.g., inclusive of an

individual who pays for a fractional interest to possess the property (his title – his right to possess) for a period of time- and a secondary investor – inclusive of a finance company, who pays for an interest after that initial period of time - in conjunction with paras. 0059-0066, showing a network utilized in the method).

Sabella does not specifically show the vehicle financing company providing financing to a vehicle consumer for the legal title price of the vehicle

Lacombe teaches a vehicle financing company providing financing to a vehicle consumer for the legal title price of the vehicle (¶0007, showing a financing company financing a vehicle).

It would have been obvious to one of ordinary skill in the art to include in the method of providing interests in property shown in Sabella the well known practice of financing the acquisition of an interest in property as taught by LaCombe since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

The recitation "for providing financing by a vehicle financing company for acquisition of a vehicle by a vehicle consumer" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to

stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

As to claim 3, Sabella in view of LaCombe shows the method of claim 1. Sabella further shows receiving at or near the end of the legal title term an unrestricted legal title price and transferring the future interest to the vehicle consumer so that the vehicle consumer receives the future interest and unrestricted legal title in the vehicle (paras. 0007, 0008, 0031, 0034, showing all fractional interests in primary investor and paying to acquire those interests).

As to claim 4, Sabella in view of LaCombe shows the method of claim 1. Sabella further shows wherein the future interest is a reversionary interest or a remainder (para. 0008, showing a reversionary interest).

As to claim 7, Sabella in view of LaCombe shows all elements of claim 1. Sabella further shows the vehicle consumer receiving the legal title in the vehicle ((paras. 0007, 0008, 0031, 0034, showing all fractional interests in primary investor and paying to acquire those interests).

As to claim 11, Sabella in view of LaCombe shows the method of claim 1. Sabella further shows wherein the legal title term is in the range of one year to six years (para. 0007, showing less than 10 years, which encompasses this range).

As to claim 12, Sabella in view of LaCombe shows the method of claim 1. Sabella further shows a future interest vesting upon expiration of a vesting period (paras. 0007-0008).

As to claim 13, Sabella in view of LaCombe shows the method of claim 1. LaCombe further shows receiving a financed legal title price through a number of periodic payments (para. 0007, describing a financing as receiving periodic payments).

It would have been obvious to one of ordinary skill in the art to include in the method of providing interests in property shown in Sabella the well known practice of financing the acquisition of an interest in property and receiving periodic payments as taught by LaCombe since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

The limitations of claim 35 parallel the limitations of claim 1 as set forth above and are, therefore, rejected under the same rationale.

As to claim 36, Sabella in view of LaCombe shows the method of claim 35. Sabella further shows personal property selected from the group consisting of: a tangible personal property and an intangible personal property (paras. 0021 and 0024).

As to claims 37 and 38, Sabella in view of LaCombe shows the method of claim 35. Sabella further shows wherein the personal property is a good or a vehicle (paras. 0021 and 0024).

Although the cited reference addresses the claim language, Examiner notes that the recitations of personal property as a "good" and as a "vehicle" constitute nonfunctional descriptive material that is not afforded patentable weight. These

recitations do not further functionally limit the claimed method steps. Thus, this nonfunctional descriptive material will not distinguish the claimed invention from the prior art in terms of patentability, see *In re Gulack*, 703 F. 2d 1381, 1385, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F. 3d 1579, 32 USPQ 2d 1031 (Fed. Cir. 1994). (Also see Ex parte William E. Mahoney and Ed J. Dewey, Appeal No. 2004-2093, Bd. Pat. App. & Int. 2004).

The limitations of claim 39 parallel the limitations of claim 3 as set forth above and are therefore rejected under the same rationale.

12. Claims 2, 8, 9 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sabella in view of LaCombe and further in view of Gill (U.S. 4,736,294).

As to claim 2, Sabella in view of LaCombe shows the method of claim 1.

Sabella in view of LaCombe does not specifically show determining a present/future ratio representing the ratio of the legal title price to the future interest price.

Gill teaches determining a present/future ratio representing the ratio of the legal title price to the future interest price (Figs. 4, 5, showing identification and arithmetic manipulation of variables associated with vehicle financing).

It would have been obvious to one of ordinary skill in the art to have incorporated in the invention of Sabella in view of LaCombe, as a matter of design choice, the ability to determine which variables to further manipulate depending on the information desired as taught by Gill since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function

as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As to claim 8, Sabella in view of LaCombe and further in view of Gill shows the method of claim 2.

The recitation "wherein the present future interest ratio is in a range of 3:1 to 2:3" is not afforded patentable weight because the clause merely sets forth an expected or desired result of the method step. Further, applicant has not set forth in the specification the criticality of this particular range.

As to claim 9, Sabella in view of LaCombe and further in view of Gill shows the method of claim 2. LaCombe further shows wherein the present/future interest ratio is based on one or more of the following factors: a consumer trade-in of an existing vehicle, a residual value of the vehicle, or dealer promotions (¶0037, showing residual value as part of insurance to be paid for which contributes to vehicle pricing).

As to claim 41, Sabella shows a method for providing financing by a vehicle financing company for acquisition of a vehicle by a vehicle consumer, the method comprising:

receiving a future interest in a vehicle by a vehicle financing company in consideration for a future interest price paid by the vehicle financing company upon transfer of a legal title in the vehicle to a vehicle consumer in consideration for a legal title price for a legal title term, the legal title price being an amount of money paid for a present possessory interest in the vehicle, wherein the receiving step is accomplished at least partially by utilizing an at least one computer and at least one computer network

(paras. 0002, 0008, 0021-0027, 0030-0034, showing a seller parceling interests in property, inclusive of tangible property that is not real estate, to individuals or entities who desire an interest in that property. A primary investor – e.g., inclusive of an individual who pays for a fractional interest to possess the property (his title – his right to possess) for a period of time- and a secondary investor – inclusive of a finance company, who pays for an interest after that initial period of time - in conjunction with paras. 0059-0066, showing a network utilized in the method).

Sabella does not specifically show receiving the financed legal title price through a number of periodic payments.

LaCombe teaches receiving a financed legal title price through a number of periodic payments (para. 0007, describing a financing as receiving periodic payments).

It would have been obvious to one of ordinary skill in the art to include in the method of providing interests in property shown in Sabella the well known practice of financing the acquisition of an interest in property and receiving periodic payments as taught by LaCombe since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Sabella in view of LaCombe does not specifically show determining a present/future ratio representing the ratio of the legal title price to the future interest price.

Gill teaches determining a present/future ratio representing the ratio of the legal title price to the future interest price (Figs. 4, 5, showing identification and arithmetic manipulation of variables associated with vehicle financing).

It would have been obvious to one of ordinary skill in the art to have incorporated in the invention of Sabella in view of LaCombe, as a matter of design choice, the ability to determine which variables to further manipulate depending on the information desired as taught by Gill since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

The recitation "for providing financing by a vehicle financing company for acquisition of a vehicle by a vehicle consumer" has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See In re Hirao, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and Kropa v. Robie, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

13. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sabella in view of LaCombe and further in view of Reynolds (U.S. 7,024,373).

As to claim 6, Sabella in view of LaCombe shows the method of claim 1.

Sabella in view of LaCombe does not specifically show a vehicle dealer transferring the vehicle to the vehicle consumer.

Reynolds teaches a vehicle dealer transferring a vehicle (col. 3, lines 16-21 and col. 9, lines 6-16).

It would have been obvious to one of ordinary skill in the art to have incorporated in the invention of Sabella in view of LaCombe the ability to provide the actual property as taught by Reynolds since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Graff (U.S. 6,167,384) – showing providing titles for various interests in real and personal property

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carol See whose telephone number is (571)272-9742. The examiner can normally be reached on Monday - Thursday 6:45 am - 5:15 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Dixon, can be reached on (571) 272-6803. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ella Colbert/
Primary Examiner, Art Unit 3696

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